

## REMARKS

### **(A) STATUS OF THE APPLICATION**

Applicants thank the Examiner for her explanation of the rejections in the Final Office Action dated August 16, 2006 and the Advisory Action dated October 30, 2006.

#### **(I) DISPOSITION OF CLAIMS**

- (i) Claims 1-6, 8-10, 12, and 13 are pending in the application.
- (ii) Claims 7, 11, and 14-41 have been previously canceled.
- (iii) Claims 13 is rejected under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph.
- (iv) Claims 1-3, 5-6, 8-10, and 13 are rejected under 35 U.S.C. § 102(b).

#### **(II) APPLICANTS' ACTION**

- (i) Claim 1 was amended to remove "body fittings" from the substrate list.
- (ii) Claim 13 was amended to delete the term "only" from the claim.
- (iii) No new matter was added.

### **(B) RESPONSE TO REJECTION UNDER 35 U.S.C. § 112, 2<sup>ND</sup> PARAGRAPH-CLAIM 13**

Claim 13 was rejected under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants' amendment to Claim 13 should obviate this rejection.

### **(C) RESPONSE TO REJECTION UNDER 35 U.S.C. § 102(B)-CLAIMS 1-3, 5-6, 8-10, & 13** U.S. PATENT NO. 4,315,790 TO RATTEE, ET AL.

Claims 1-3, 5-6, 8-10, and 13 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,315,790 to Rattee, *et al.* (*hereinafter* "Rattee"). Applicants respectfully traverse this rejection.

According to the MPEP § 2131.02(A) “[a] genus does not always anticipate a claim to a species within the genus.” While “the disclosure of a small genus may anticipate the species of that genus even if the species are not themselves recited,”<sup>1</sup> and “when the species is clearly named, the species claim is anticipated no matter how many other species are additionally named,”<sup>2</sup> neither of these are the case here.

In fact, the genus disclosed in Rattee is exceptionally broad, covering “any flexible substrate which needs to be decorated like a textile” (See Col. 1, Lines 10-11). With such a statement, one could envision that Rattee’s flexible substrate is *anything* that is not rigid. Rattee also does not clearly name any species related to automobiles,<sup>3</sup> only naming “textile fabrics” as a preferred subgenus (Col. 1, Lines 4-6). Applicants’ substrates, on the other hand, are restricted to automotive bodies and body parts, a far narrower group than that disclosed in Rattee, and not part of the textile fabric subgenus.

Applicants therefore respectfully submit that Rattee fails to anticipate Claim 1 of the invention. As such, the dependent claims thereto should also be novel.

**(D) RESPONSE TO REJECTION UNDER 35 U.S.C. 103(A)-CLAIMS 4 & 12**  
**U.S. PATENT NO. 4,315,790 TO RATTEE, ET AL.**

Claims 4 and 12 are rejected under 35 U.S.C. § 103(a) as being obvious over Rattee. Applicants respectfully traverse these rejections.

According to the MPEP § 2143.01(I), to establish a *prima facie* case of obviousness, *inter alia*, there must be some suggestion in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference to produce Applicants’ claimed invention. A broad disclosure of the decoration of “any flexible substrate which needs to be decorated like a textile” is *not*

<sup>1</sup> *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1380 (Fed. Cir. 2001).

<sup>2</sup> See MPEP § 2131.02(A).

<sup>3</sup> The only species that appear to be named in Rattee are types of fabrics found in the examples, such as a knitted cotton T-shirt, mercerized cotton, cotton/polynosic rayon blend, woven cotton, and knitted polynosic rayon.

According to the MPEP § 2143.01(I), to establish a *prima facie* case of obviousness, *inter alia*, there must be some suggestion in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference to produce Applicants' claimed invention. A broad disclosure of the decoration of "any flexible substrate which needs to be decorated like a textile" is *not* a suggestion to coat the automotive bodies, and body parts claimed by Applicants. "The fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness."<sup>4</sup> Nothing in the remainder of Rattee provides such a suggestion, either.

Because a *prima facie* case of obviousness cannot be established against Claim 1, Applicants respectfully submit that dependent Claims 4 and 12 cannot be obvious over Rattee.

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<sup>4</sup> See generally MPEP § 2144.08(II).

### CONCLUSION

In view of the above remarks, Applicants respectfully submit that stated grounds of rejection have been properly traversed, accommodated, or rendered moot and that a complete response has been made to the Office Action mailed on August 16, 2006 and the Advisory Action mailed on October 30, 2006.

Therefore, Applicants believe that the application stands in condition for allowance with withdrawal of all grounds of rejection. A Notice of Allowance is respectfully solicited. If the Examiner has questions regarding the application or the contents of this response, the Examiner is invited to contact the undersigned at the number provided.

Should there be a fee due which is not accounted for, please charge such fee to Deposit Account No. 04-1928.

Respectfully Submitted,

BY:

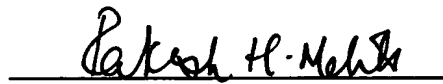
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